

Appl. No. : **10/810,660**
Filed : **Marych 29, 2004**

REMARKS

No amendments are made herein. Claims 1-37, 74, and 75 are pending. Applicants note with appreciation that Claims 4, 7, 10, 13, 16, and 19 are allowed. Claim 33, 74, and 75 were not addressed in the Office Action.

The Examiner maintained rejections of Claims 1-3, 5-6, 11-12, 14-15, 17-18, 29, 24-28, 31-32, and 36-37 under 35 U.S.C. § 102(b) as being anticipated by Miles (U.S. Patent No. 5,835,255). The Examiner also maintained rejections of Claims 8, 9, 20-23, 30, and 34-35 under 35 U.S.C. § 103(a) as being obvious over Miles in view of Gotoh et al. (U.S. Patent No. 5,824,608). The Applicants respectfully traverse.

With respect to Claims 1-3, 5-6, 8-9, 11-12, 14-15, 20-37, and 74-75, the Examiner gave no patentable weight to the limitations “wherein the conductor layer is susceptible to etching by an etchant suitable to remove the sacrificial layer” and “wherein the first material layer is adapted to protect the second electrode from etching when the sacrificial layer is removed using the etchant.” The Examiner argued that method or process limitations are not read into device claims and that product-by-process claims are not limited to the manipulations of the recited steps.

The Applicants respectfully submit that the rejected claims are not product-by-process claims. Nor is the limitation above a method or process limitation or an intended use. Rather, the claim clearly limits material (*i.e.*, structural) properties of the conductive layer and the first material layer relative to the sacrificial layer. Namely, all three materials must be such that an etchant exists which will (1) etch the sacrificial layer; (2) etch the conductor layer; and (3) not etch the material layer. No method/process steps are recited; rather the limitation merely specifies what would happen to the various materials in the face of an etchant that etches the sacrificial layer. The skilled artisan will appreciate that these limitations would be met by the correct materials (e.g., Applicants’ preferred embodiments) regardless of whether any etching steps are actually conducted.

Thus, the language ignored by the examiner positively defines chemical properties of the conductor layer and first material layer. There is not positive recitation of process steps for obtaining a product and hence are not product-by-process limitations. The limitations do include

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functional language, but there is nothing wrong with defining structural limitations by way of functional language, and the Examiner is not at liberty to ignore such limitations.

Defining structural features by their properties or functions they serve is appropriate and should be accorded patentable weight. *See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1435 (Fed. Cir. 1988) (stating that “[o]n occasion ... structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”). In *du Pont*, the Federal Circuit held that claiming a polymer based on its “Elmendorf tear strength” rather than its specific structure is appropriate and that this property limitation needs to be considered when determining the claim’s validity over prior art. *See id.* at 1434-1436. *See also In re Echerd*, 471 F.2d 632, 635 (CCPA 1973) (holding that in a structure claim “[t]here is nothing intrinsically wrong in defining something by what it does rather than by what it is” and that “these potentially distinguishing features cannot simply be ignored.”); *In re Venezia*, 530 F.2d 956, 959 (CCPA 1976) (stating that “[w]e see nothing wrong in defining the structures of components ... in terms of ... the attributes they must possess.”). Similarly, the language used by the Applicants further define the conductor layer and first material layer structures based on the properties of their respective materials. The Applicants respectfully submit that the Examiner must give all limitations in the claims patentable weight, whether they define structure explicitly or by property, and that none of the art cited by the Examiner discloses all of these limitations.

With respect to Claims 17 and 18, the Examiner has not identified any prior art disclosing the limitation of a material layer comprising macromolecule materials such as paraffin. Accordingly, the Applicants respectfully submit that Claims 17 and 18 are allowable. The same arguments apply to Claim 33, which was not addressed by the Examiner

With respect to Claim 28, the Examiner has not identified any prior art disclosing that the material of the sacrificial layer is a metal or silicon. For this additional reason, the Applicants respectfully submit that Claim 28 is allowable.

As noted above, the Examiner did not address Claims 74 and 75 (which depend from Claims 1 and 27, respectively). However, the Applicants submit that none of the cited art discloses that the material of the sacrificial layer is amorphous silicon. Accordingly, for this additional reason the Applicants respectfully submit that Claims 74 and 75 are allowable.

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No fees are believed due; however, please charge any fees, including any fees for extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 5-17-07

By: Ryan E. Melnick
Ryan E. Melnick
Registration No. 58,621
Attorney of Record
Customer No. 20,995
(619) 235-8550

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